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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/892,043

06/26/2001

Dale F. McIntyre

83013F-P

1730

7590

08/07/2008

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EXAMINER

FLEURANTIN, JEAN B

ART UNIT

PAPER NUMBER

2162

MAIL DATE

DELIVERY MODE

08/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/892,043	<b>Applicant(s)</b> MCINTYRE, DALE F.	
	<b>Examiner</b> JEAN B. FLEURANTIN	<b>Art Unit</b> 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on BPAI May 29, 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. In view of the Board Decision filed on May 29, 2008, PROSECUTION IS HEREBY REOPENED.

The action set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Mohammad Ali/

Supervisory Patent Examiner, Art Unit 2169

The following is the current status of claims:

Claims 1-24 remain pending for examination.

### ***Duplicate Claim Objections***

Claims 13 and 24 are objected under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See **MPEP § 706.03(k)**.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "said instructions being associated with a digital media file stored on said user computer" which renders the claim indefinite.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106:

As per independent claim 12

The independent claim 12 is directed to a "system". The claimed steps are not being performed by any form of computer hardware component. Therefore, the mechanism for restoring a scanned high resolution image file created from an older as the purpose of the invention. The claimed, "system" fails to fall with one of four statutory categories of invention, process, machine, manufacture and composition, and is software per se.

Any dependent claim rejects under the same rational.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by USPT. 6,745,186 issued to Testa et al., (“Testa”).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As per claim 1, Testa discloses “a method for providing an automatic service over a communication network to a user based on stored instructions by a user on a user computer” [i.e., automatically organizing the plurality of digital images into selected groups in accordance with instruction; see col. 2, lines 43-47], comprising the steps of:

“a service provider automatically obtaining instructions stored on a user computer over said communication network” [i.e., automatically obtaining the personal information of the customer in a quick and efficient manner; see col. 6, lines 56-62], “said instructions being associated with a digital media file stored on said user computer” [i.e., receiving instruction forms whereas the compartment is designed to receive items having images stored thereon; see col. 10, lines 11-14]; and

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“implementing said instructions with respect to said associated digital image file” [i.e., identifying what is to be done with associated images; see col. 10, lines 46-49].

As per claim 2, Testa discloses “instructions relating the sale of rights to use and/or reproduce said image” [i.e., instructions as to what is to be done with the digital images that are obtained; see col. 6, lines 62-64].

As per claim 3, Testa discloses “the purchase, use, or sale of an item displayed in said image” [i.e., visual format; see col. 6, lines 46-49].

As per claim 4, Testa discloses “said instruction was entered on a form” [see figure 4, item 60 and col. 60, lines 50-51].

As per claim 5, Testa discloses “said form is displayed in association with said image” [see figure 4, item 60 and col. 60, lines 50-52].

As per claim 6, Testa discloses “said form is stored remotely at the service provider” [i.e., orders have been placed over the internet; see col. 4, lines 54-55].

As per claim 7, Testa discloses “the service provider recognizes that a digital image file has been identified for a service during a routine communication interval” [see col. 13, lines 18-23].

As per claim 8, Testa discloses “an electronic form is provided to the user by service provider in response to discovering of the identified digital image file” [see col. 13, lines 43-49].

As per claim 9, Testa discloses “a metadata field of the identified digital image file is modified to reflect the data added to the electronic form” [see col. 13, lines 16-30].

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As per claim 10, Testa discloses “the metadata field is provided in said service provider computer” [see col. 13, lines 18-23].

As per claim 11, Testa discloses “the metadata field is provided in said user computer” [see col. 13, lines 18-23].

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#### **CONTACT INFORMATION**

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 – 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 – 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JEAN B. FLEURANTIN/

Primary Examiner, Art Unit 2162